

Remarks

A. Status of the Claims

No claims have been amended, cancelled, or added. Therefore, claims 45-55, 57-59, and 62-66 are pending, with claims 57-59, 62, and 67-71 being withdrawn from consideration at this time as being directed to a non-elected invention.

B. Restriction Requirement

Applicant requests that the method claims be rejoined, as the composition and method claims both share a general inventive concept that has a special technical feature that is not disclosed by the cited art (see below arguments). Further, the composition claims are believed to be allowable, which provides an additional ground for rejoining the Group II method claims.

C. Obviousness Rejections

Three separate obviousness rejections have been advanced by the Examiner. The focus of this response will be on the rejection relating to independent claim 63, for if an independent claim is patentable over the cited art, then dependent claims are also patentable.

1. The obviousness rejection of claim 63 is legally flawed

Claim 63 is said to be over U.S. Publication 2005/0196626 (“Knox”) in view of U.S. Publication 2003/0082399 (“He”) and U.S. Patent 6,489,028 (“Degand”) as further evidenced by Hawley’s Condensed Chemical Dictionary and U.S. Publication 2008/0311287 (“Chen”). Knox is used as the primary reference even though the Examiner concedes that it fails to disclose the addition of a swelling agent (Action at page 4). He is used to supplement Knox’s deficiency. Chen is used to support a motivation/apparent reason to combine Knox with He:

The motivation for using [a] coating composition comprising a swelling agent such as alcohol and ketone or just alcohol by itself is to promote adhesion between the layer to a substrate (Chen US 2008/0311287, para 0057).

In light of the motivation of using [a] coating composition comprising a swelling agent such as alcohol and ketone as taught by Chen as described above, it

therefore would have been obvious to one of ordinary skill in the art at the time of invention to use the coating compositing comprising a swelling agent of He or Degand on the colored latex layer of Knox motivated by the desire to have an excellent adhesion between the two layers.

Action at pages 5-6.

As evidenced by the above paragraphs, Chen is actively being used to support the Examiner's rational of combining Knox (or Degand) with He. The problem with this position, however, is that Chen is not prior art to the claimed invention.

In particular, Chen's earliest possible 102(e) prior art date is December 21, 2006. By comparison, Applicant's claimed invention enjoys a priority date of April 16, 2004. Given this, the Examiner's motivation/apparent reason to combine Knox (or Degand) with He relies on a reference, Chen, which is not prior art to the claimed invention.

Therefore, the Examiner's position is legally flawed and should be withdrawn for at least this reason.

2. The obviousness rejection of claim 63 is not supported by the cited art

The Examiner's response to Applicant's previous hindsight argument is respectfully deficient. The Examiner makes the following statement:

...it should be noted that Knox does not disclose a vast number of pigments from which to choose. Further, Knox explicitly discloses pigments such as colloidal silica, titanium oxide, cesium oxide and mixtures thereof. Therefore, absent evidence to the contrary, one of the ordinary skill in the art would be motivated to pick colloidal silica, titanium oxide mixed together with the polyurethane latex in the photochromic polymeric coating composition.

Action at pages 8-9. The Examiner's position appears to be that a person having ordinary skill in the relevant field would simply have to select between one of three particles to meet the limitations of Applicant's claim 63.

The list of particles is far more extensive than the three noted by the Examiner. For instance, the list that includes titanium dioxide, colloidal silica, and cesium oxide also includes

several other particles: fumed silica; amorphous silica; alumina; colloidal alumina; yttrium oxide; colloidal yttria; zirconia; colloidal zirconia; or any mixtures thereof (see paragraph [0089] of Knox). In addition to these particles, Knox also includes the following paragraphs of other types of particles that can be used:

[0086] The particles used in the photochromic polymeric coating can comprise inorganic elements or compounds known in the art. Particles can be formed from ceramic materials, metallic materials, and mixtures of any of the foregoing. Ceramic materials comprise metal oxides, metal nitrides, metal carbides, metal sulfides, metal silicates, metal borides, metal carbonates and mixtures of any of the foregoing. Specific, non-limiting examples of metal nitrides are, for example boron nitride; specific, non-limiting examples of metal oxides are, for example zinc oxide; non-limiting examples of suitable metal sulfides are, for example molybdenum disulfide, tantalum disulfide, tungsten disulfide and zinc sulfide; non-limiting suitable examples of metal silicates are, for example aluminum silicates and magnesium silicates, such as vermiculite.

[0088] Non-polymeric, inorganic materials useful in forming the particles incorporated into the photochromic polymeric coating can comprise inorganic materials chosen from oxides, carbides, nitrides, borides, sulfides, silicates, carbonates, sulfates or hydroxides. A non-limiting example of a useful inorganic oxide is zinc oxide. Non-limiting examples of suitable inorganic sulfides include molybdenum disulfide, tantalum disulfide, tungsten disulfide, and zinc sulfide. Non-limiting examples of useful inorganic silicates include aluminum silicates and magnesium silicates, such as vermiculite.

It is clear that the list of particles that can be selected in Knox is far greater than what the Examiner references at page 8 of the Action. Further, the particles referenced by the examiner are not even referred to as "pigments":

As used herein, the term "based on total weight of the resin solids" of the components which form the composition means that the amount of the component added during the formation of the composition is based upon the total weight of the solids (non-volatiles) of the polysiloxane, any film-forming component, any

curing agent present during the formation of the composition, and any silyl-blocked material present, **but not including the particles, any solvent, or any additive solids such as hindered amine stabilizers, catalysts, pigments including extender pigments and fillers, photoinitiators, flow additives, and UV light absorbers.**

Knox at paragraph [0092] (emphasis added). The emphasized language distinguishes between the particles disclosed in Knox with pigments that can be added to the compositions. Therefore, and based on the Examiner's own rationale, if one of skill in the art desired to use pigments with Knox's disclosed compositions, such a person would have likely selected something other than colloidal silica, titanium oxide, or cesium oxide as the pigment. Stated another way, the Examiner's rationale for focusing on only three of the multitude of particles disclosed in Knox is faulty.

In addition to the particle selection process, a person having ordinary skill would also have to select application of the composition under a latex form as presently claimed over the application of a composition comprising precursor monomers as described in paragraph [0146] of Knox.

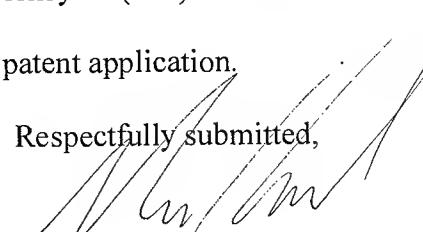
Applicant again respectfully submits that hindsight reasoning is being used to build the current obviousness rejection. The reality of Knox is that it discloses a multitude of different combinations that a person having ordinary skill in the art can make (*e.g.*, particles and composition forms). The Examiner's selection process appears to be based on Applicant's claimed invention and corresponding specification. Without this roadmap, the selection made by the Examiner would likely have been different, as Knox simply provides no apparent reason to a person considering Knox's disclosure to reach the Examiner's selection.

Applicant respectfully requests that the obviousness rejections be withdrawn for at least these reasons.

D. Conclusion

Applicant believes that the present document is a complete response to the Office Action. The present case is in condition for allowance and such favorable action is requested. The Examiner is invited to contact the undersigned attorney at (512) 536-3020 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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